

Remarks/Arguments

In paragraph 1 of the Official Action the language “at least one corresponding foot of the microscope on the stand base” was said to be unclear. The word “corresponding” has been deleted, so as to obviate the objection.

At paragraph 3 of the Official Action, claims 17-21 and 31 were rejected under 35 U.S.C. 103(a) for reasons of obviousness over Mitzkus et al (US Pat. 6,717,724) in view of McGrath et al (US Pat. 5,810,301). This ground of rejection is courteously traversed.

The last paragraph on page 2 of the Official Action acknowledges that Mitzkus et al do not teach the left and right hand rests pivoting freely and independently of one another. Nevertheless, the Official Action concludes McGrath et al (Figs. 1-3) teach right and left hand rests 34 moving freely and independently of one another, and therefore, it would have been obvious to have made the hand rests of Mitzkus et al move freely and independently.

Applicants courteously disagree.

Mitzkus et al employ base plates (1) which are functionally the hand rests of the device. Mitzkus et al also employ a catch mechanism (6) (Fig. 1) which bridges the two hand rests (base plates) (1). The “bridge” includes a “complementary piece” (15) plus a mounting plate (17), best illustrated by Fig. 4 of Mitzkus et al. According to Mitzkus et al, the mounting plate is fixedly connected to the base plates (1). That is, the mounting plate (17) (and also the complementary piece 15), maintains the hand rests/base plates so they are stationary, and non-movable.

Accordingly, one aspect of the inventive concept of Mitzkus et al is dependent on mounting plate (17) and complementary piece (15) for effectively bridging the base plates (1) and preventing the independent and free movement of the hand rests relative to one another.

While McGrath may disclose right and left arm rests 34 which can pivot independently of one another in an arc (54), this pivoting action would be contrary to the fundamental teachings of Mitzkus et al. As previously pointed out, Mitzkus et al teach a microscope support with structural features (mounting plate (17) and complementary piece (15)) which prevent movement of their hand rests/base plates. The rejection presupposes the removal of these parts from Mitzkus et al as to allow independent and free movement of the hand rests in view of McGrath et al.

Applicants maintain McGrath et al may not be properly combined with Mitzkus et al to support the rejection of the claims under Section 103 relative to the movement of the hand rests, since to do so would effectively destroy the invention upon which Mitzkus et al is based, namely arm rests which are **stationary, and not moveable**. *Ex parte Hartmann* 186 USPQ 366, 367 (Pat & TM Off. Bd. Appeals 1974).

While references may be combined to establish obviousness under Section 103, they may not be so combined when to do so would alter, so as to destroy the invention of one of the references, namely Mitzkus et al where the removal of the bridging mechanism, for example, for retaining the hand rests in a **stationary mode** is a necessary and fundamental, non-optional feature of the microscope support of the invention. *Ex parte Hartmann, supra*

McGrath et al disclose arm rests (34) apparently freely movable along a lateral path (55). However, it is not apparent from McGrath et al how the stationary arm rests of Mitzkus et al may be made laterally pivotal, so they are freely and independently movable relative to one another. Besides, the hand rests of Mitzkus et al are clearly stationary. **This is acknowledged at the bottom of page 2 of the Official Action.**

Moreover, in assessing patentability on the question of obviousness, it is improper to simply “pick n’ choose” only those elements from the prior art device needed to meet Applicant’s claimed invention, and exclude those elements from the same prior art that may not be needed. For example, the device of McGrath et al employs a counter-balance member to prevent the assembly from tipping, yet the Official Action fails to mention the counter-balance feature. The introduction of just the pivoting arm rests of McGrath et al to the exclusion of other elements of this reference’s device is evidence of **prohibited hindsight reconstruction** wherein Applicant’s invention becomes obvious from the benefit of a prior reading of Applicant’s own disclosure. Such hindsight is prohibited under 35 U.S.C. 103, and as held in numerous court holdings.

Importantly, the Official Action fails to disclose how the conclusion of obviousness was arrived at in combining the two references. This is because obviousness cannot be established by simply combining the teachings of the prior art to produce the claimed invention, **absent some teaching, suggestion or incentive supporting the combination**. *In re Geiger* 2 USPQ2d 1276 In order to establish a *prime facie* case of obviousness the prior art needs to provide the rationale

for combining and modifying references. In this instance, the rationale for modifying Mitzkus et al in view of the acknowledged stationary, non-pivoting arm rests of this reference.

It is also worth noting, Mitzkus et al achieve their ergonomic support by means of rotating adjustable feet (4-5) in the rear area of the hand rest/base plate 1. This adjusts the height and accordingly, the inclination of plate 2 relative to base plate 1. In addition, the height of the microscope fastened to plate 2 is also changed, at the same time. The height of the plate 2 is adjusted at the front by a catch mechanism 13. Hence, Mitzkus et al provide no plausible basis for incorporating the pivoting arm rests of McGrath et al into the microscope support of the primary reference, as alleged.

With regard to claim 18 and the recitation of a hinge system for affixing the right and left hand rest to the lateral cheekpiece, Mitzkus et al fail to teach or suggest a hinge system (8), as alleged in the Official Action. Mitzkus et al merely describe plate 2 (and not base plate 1/hand rests) as tiltable relative to plate 1 by means of pin (8). There is no hinge system disclosed by Mitzkus et al for affixing the right and left hand rests to the cheekpiece, as urged in the Office Action. Besides, Claim 18 also includes all the limitations of claim 17 from which claim 18 depends. This includes the inability to combine the teachings of McGrath et al with those of Mitzkus et al, for reasons outlined above.

Regarding claim 19, the Office Action urges the left and right hand rests can be hooked via element (8) onto the left and right lateral cheekpiece of the body. Mitzkus et al do not teach or suggest this feature, contrary to the Official Action. Col. 3, lines 3-4 of Mitzkus et al state that plate 2, and not hand rests 1, is tiltable relative to plate 1 by means of the pin 8.

With regard to claim 20, Mitzkus et al do teach a tapered hand rest toward the front edge. Nevertheless, claim 20 includes all the limitations of claim 17, i.e., including a left and a right hand rest attached to the body so as to pivot freely and independently of one another. For reasons outlined above relative to the combination of McGrath et al with the primary reference, Mitzkus et al, the teaching of pivotal arm rests according to McGrath et al may not be combined with the stationary hand rests of Mitzkus et al. To do otherwise would otherwise destroy the fundamental features of Mitzkus et al, which relies on *inter-alia* a stationary, non-movable arm rest.

Claims 21 and 31 are also patentable over the combination of Mitzkus et al in view of McGrath et al. Claims 21 and 31 are directly dependent from claim 17, and therefore, include hand rests that pivot freely and independently of one another. For reasons outlined above relative to the impropriety of modifying the stationary hand rests of Mitzkus et al, so they pivot freely according to McGrath et al, claim 21 and 31 are patentable over the cited references.

In view of the foregoing discussion, reconsideration and withdrawal of the rejection of claims 17-21 and 31 as being unpatentable over Mitzkus et al in view of McGrath et al are courteously requested.

At paragraph (4.) of the Official Action claims 1-8, 12-16 and 27-30 were rejected under 35 U.S.C. 103(a) as unpatentable over Mitzkus et al in view of McGrath et al, taken further in view of Kline et al (US Pat. 5,195,705). This ground of rejection is courteously traversed.

The inappropriate conversion of the microscope support of Mitzkus et al in view of McGrath et al from one having stationary, non-pivoting hand rests by removing fundamental bridging components between the hand rests would effectively destroy the invention upon which Mitzkus et al is based. This avoids a conclusion of obviousness under Section 103, as previously discussed. Other reasons outlined above in connection with the previous ground of rejection, namely the selective introduction of structural features from McGrath et al to the exclusion of other structural features of the microscope support of the reference is further evidence of hindsight reconstruction (prohibited).

With regard to Kline et al, this reference allegedly discloses a microscope 14 positioned on a microscope stand 12. While Fig. 1 of the drawings illustrate the base of microscope 14 positioned on the top plate 22 of stand 12, there is no express (written) teaching that the contour of the microscope base need coincide with the top plate 22 of the microscope stand 12.

In this regard, page 2100-66 of the MPEP discusses the rule regarding the citation of drawings where a reference fails to disclose the drawings were drawn to scale. The MPEP provides that patent drawings may not be relied on for precise proportions of the elements and may not be relied on to show particular sizes when the specification is completely silent on the question.

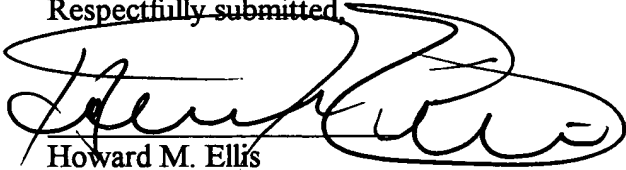
As previously mentioned, the written specification of Kline et al is totally silent on the matter of the contour or dimensions of the microscope base relative to the top plate 22 of microscope stand 12. And, in addition, there is no disclosure that the drawings of Kline et al were made to scale. That is to say, because Kline et al is silent on the matter of the dimensions (i.e., the outer contour) of the microscope base and those of the top plate (22) of the microscope stand are the same or even approximately the same, the patent drawings alone may not be relied on as an enabling teaching of the contour or dimensions of the microscope base as necessarily substantially coinciding with those of top plate (22). Accordingly, Fig. 1 of Kline et al does not provide the factual support for the conclusion that claims 1-8, 12-16 and 27-30 are obvious, and therefore, unpatentable under 35 U.S.C. 103(a).

Accordingly, reconsideration and withdrawal of the rejection of claims 1-8, 12-16 and 27-30 are obvious, and therefore, unpatentable under 35 U.S.C. 103(a), are courteously solicited.

Page 6 of the Official Action indicates the presence of allowable subject matter in connection with claims 9-11 and 22-26. In this regard, claims 9 and 22 have been rewritten in independent form with the inclusion of all limitations from the claims they originally depended from. Therefore, claims 9-11 and 22-26 should now be in condition for allowance.

In view of the amendments to the claims and the foregoing remarks distinguishing the claimed invention over the references applied in rejecting the claims, this application should now be in condition for allowance. Such action at an early date is earnestly solicited.

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